

MAY 04 2009

Docket No. 2685/113692

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventors: Jocelyn Cloutier et al.
Serial No.: 09/736,430
Filing Date: December 16, 2000
For: Synchronous Transmission of Data with
Network Remote Control

Art Unit: 2643
Examiner: Not Assigned

Assistant Commissioner for Patents
Washington D.C. 20231

**PETITION FOR FILING BY OTHER THAN ALL THE INVENTORS UNDER
37 C.F.R. 1.47(a)**

SIR:

Applicants, Allen E. Milewski and Thomas M. Smith, hereby petition the Assistant Commissioner to accept the filing of the above-identified patent application by other than all of the inventors.

An affidavit and an exhibit are attached hereto providing proof of the pertinent facts concerning the refusal of the co-Inventor to join in the present application for patent.

The name and last-known address of the co-inventor refusing to join in this application is as follows:

Jocelyn Cloutier
770 18th Avenue
Menlo Park, California 94025

The invention was developed in conjunction with and the authorization of AT&T Corp. by Jocelyn Cloutier, Allen E. Milewski and Thomas M. Smith, each of whom were employees of AT&T Corp. at the time of the invention disclosed in the above-referenced patent application.

MAY 04 2009

Upon information and belief, based on the precedent which will be discussed below, AT&T is entitled to clear title to the invention and to the above-identified patent application and any patent which issues thereon.

The Supreme Court of the United States in *Solomons v. United States* 137 U.S. 342, 346 (1890) held:

If one is employed to devise or perfect an instrument, or a means for accomplishing a prescribed result, he cannot, after successfully accomplishing the work for which he was employed, plead title thereto as against his employer. That which has been employed and paid to accomplish becomes, when accomplished, the property of his employer. Whatever rights as an individual he may have had in and to his inventive powers, and that which they are able to accomplish, he was sold in advance of his employer.

It is clear that an employee who is paid to develop an invention comes within the scope of the language cited. See *In re Hobbs*, 136 U.S.P.Q 489 (Atomic Energy Comm. Pat. Comp. Bd. 1963).

Because Jocelyn Cloutier was employed by AT&T Corp. at the time of the invention, and was paid compensation to jointly develop, with Allen E. Milewski and Thomas M. Smith the method and system for synchronous transmission of data with network remote control, the invention belongs to AT&T Corp., and each individual inventor who contributed to the development of the method and system has a duty to jointly execute an application for patent covering the method and system and to assign the invention, patent application, and any patent which issues to AT&T Corp.

Allen E. Milewski and Thomas M. Smith have assigned their rights in the subject U.S. patent application to AT&T Corp. Assignee's counsel contacted Jocelyn Cloutier in a letter sent on October 19, 2000 that included a complete copy of the application papers (specification, claims, drawings and an oath and declaration), and requested that the declaration/oath and assignment be executed by Jocelyn Cloutier and be returned to assignee's counsel to complete the filing of this application. A copy of the letter is attached to this petition as Exhibit A. Further, as stated in the attached affidavit, Allen E. Milewski on numerous occasions during the period following the filing of the application contacted Mr. Cloutier to obtain Mr. Cloutier's executed declaration/oath and assignment. Despite these efforts, neither the executed

declaration/oath, nor the executed assignment has been received from Mr. Cloutier, even though an inordinately long amount of time has elapsed following the mailing of the letter of October 19, 2000.

The conduct of Jocelyn Cloutier in view of the facts stated above supports a conclusion under 37 C.F.R. § 1.47 that Jocelyn Cloutier has refused to sign the declaration/oath. Because of the refusal of co-inventor Jocelyn Cloutier to execute the papers required for filing the present patent application, Allen E. Milewski and Thomas M. Smith are believed to be entitled to make such application on behalf of and as agent for their co-inventor Jocelyn Cloutier.

This Petition is accompanied by authorization to charge the requisite fee of \$130 under 37 C.F.R. § 1.17(i) to Deposit Account 11-0600. A duplicate copy of this paper is attached for that purpose. In addition, the Commissioner is authorized to charge any underpayment, or additional fees to Deposit Account 11-0600.

It is respectfully submitted that the requirements for filing this application under 35 U.S.C. § 116 have been met.

Respectfully submitted,

Date 4/13/01

By Sinan Utlu
Sinan Utlu
Reg. No. 46,137

KENYON & KENYON
1500 K Street, NW - Suite 700
Washington, DC 20005
telephone: 202/220-4200/facsimile: 202/220-4201

DC01 362477 v 1

MAY 04 2009

Docket No. 2685/113592

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventors: Jocelyn Cloutier et al.

Serial No.: 09/736,430

Art Unit: 2643

Filing Date: December 15, 2000

Examiner: Not Assigned

For: Synchronous Transmission of Data with
Network Remote Control

Assistant Commissioner for Patents
Washington D.C. 20231

AFFIDAVIT OF ALLEN E. MILEWSKI

SIR:

Allen E. Milewski, being duly sworn, and having personal knowledge of the facts set forth herein, hereby deposes and says that:

1. I am employed as District Manager for AT&T Corp. at AT&T Corp.'s facilities at 200 Laurel Avenue, Middletown, NJ 07748, to which the present invention disclosed and claimed in the U.S. Patent Application Serial No. 09/736,430, filed on December 15, 2000 and entitled Synchronous Transmission of Data with Network Remote Control (hereinafter referred to as the "Patent Application"), belongs.

2. I am a co-inventor of the Patent Application, along with the other co-inventors, Jocelyn Cloutier and Thomas M. Smith.

3. On April 7, 2000 Jocelyn Cloutier resigned from AT&T Corp.

4. On or about October 20, 2000, I received a package containing the complete application (including specification, claims, drawings and an oath and declaration) from counsel for AT&T. I understand that the package was mailed on October 19, 2000 to each of the other

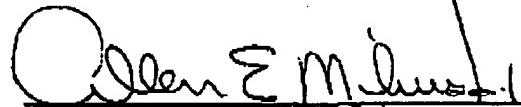
DC01 198114 v 1

MAY 04 2009

co-inventors, including Jocelyn Cloutier.

5. I have contacted Jocelyn Cloutier on numerous occasions, by telephone and e-mail, in the period following October 20, 2000, to encourage Mr. Cloutier to send the executed oath and declaration to the counsel for AT&T Corp. I understand that as of the date of this affidavit, neither AT&T Corp. nor counsel for AT&T Corp. has received Jocelyn Cloutier's executed oath and declaration.

9. It is necessary to immediately execute and file the documents associated with this Patent Application in order to prevent irreparable damage to AT&T Corp., avoid abandonment of the Patent Application, and protect the legitimate rights of AT&T Corp. in the United States.



Allen E. Milewski

Sworn to before me this 3 day of April 2001.


Debera Polizzi

Notary Public

DEBERA POLIZZI
Notary Public of New Jersey
My Commission Expires July 23, 2003

RECEIVED
CENTRAL FAX CENTER

MAY 04 2009

DOCKET NO. 2685/113592

IN THE UNITED STATES
PATENT AND TRADEMARK OFFICE

Declaration and Power of Attorney

As a below named inventor, I hereby declare that:

My residence, post office address and citizenship are as stated below next to my name.

I believe I am an original, first and joint inventor of the subject matter which is claimed and for which a patent is sought on the invention entitled **SYNCHRONOUS TRANSMISSION OF DATA WITH NETWORK REMOTE CONTROL**, the specification of which is attached hereto.

I hereby state that I have reviewed and understand the contents of the above identified specification, including the claims, as amended by an amendment, if any, specifically referred to in this oath or declaration.

I acknowledge the duty to disclose all information known to me which is material to patentability as defined in Title 37, Code of Federal Regulations, 1.56.

I hereby claim foreign priority benefits under Title 35, United States Code, 119 of any foreign application(s) for patent or inventors' certificate listed below and have also identified below any foreign application for patent or inventors' certificate having a filing date before that of the application on which priority is claimed:

None

I hereby claim the benefit under Title 35, United States Code, 120 of any United States application(s) listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States application in the manner provided by the first paragraph of Title 35, United States Code, 112, we acknowledge the duty to disclose all information known to us to be material to patentability as defined in Title 37, Code of Federal Regulations, 1.56 which became available between the filing date of the prior application and the national or PCT international filing date of this application:

Serial No.

Filed

Status:

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

I hereby appoint the following attorney(s) with full power of substitution and revocation, to prosecute said application, to make alterations and amendments therein, to receive the patent, and to transact all business in the Patent and Trademark Office connected therewith:

Samuel H. Dworetzky (Reg. No. 27873)
Thomas A. Restaino (Reg. No. 33444)
Cedric G. DeLaCruz (Reg. No. 36498)
Michele L. Conover (Reg. No. 34962)
Rohini K. Garg (Reg. No. 45272)
Benjamin S. Lee (Reg. No. 42787)
Robert B. Levy (Reg. No. 28234)
Susan E. McHale (Reg. No. 35948)
Alfred G. Steinmetz (Reg. No. 22971)

I also appoint Brian S. Mudge (Reg. No. 40,738) and Sinan Utlu (Reg. No. 46,137) of Kenyon & Kenyon as associate attorneys, with full power to prosecute said application, to make alterations and amendments therein, and to transact all business in the U.S. Patent and Trademark Office connected therewith.

Please address all correspondence to Mr. Brian S. Mudge, Kenyon & Kenyon, Suite 700, 1500 K Street NW, Washington, D.C. 20005. Telephone calls should be made to Sinan Utlu by dialing 202-220-4200.

Full name of 1st joint inventor: JOCELYN CLOUTIER

Inventor's signature _____ Date _____

Residence: Menlo, Park, California

Citizenship: CANADA

Post Office Address: 770 18th Avenue
Menlo Park, California 94025

DC01 344659 v 1

3

Full name of 2nd joint inventor: ALLEN E. MILEWSKI

Inventor's signature Allen E. Milewski

Date 10/27/00

Residence: Holmdel, New Jersey

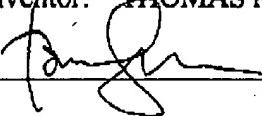
Citizenship: USA

Post Office Address: No. 11 Beacon Court
Holmdel, New Jersey 07733

DC01 344658 v 1

PAGE 12/27 * RCVD AT 5/4/2009 1:07:16 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-6/46 * DNIS:2738300 * CSID:(815)301-3847 * DURATION (mm:ss):07-10

Full name of 3rd joint inventor: THOMAS M. SMITH

Inventor's signature  Date 10/27/2000

Residence: Westfield, New Jersey

Citizenship: USA

Post Office Address: No. 849 Tice Place
Westfield, New Jersey 07090

RECEIVED
CENTRAL FAX CENTER

MAY 04 2009



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Paper No. 8

KENYON & KENYON
1500 K STREET, N.W.
SUITE 700
WASHINGTON, DC 20005

COPY MAILED

JUN 26 2001

OFFICE OF PETITIONS
A/C PATENTS

In re application of
Cloutier, Milewski and Smith :
Application No. 09/736,430 : DECISION ACCORDING
Filed: December 15, 2000 : STATUS UNDER 37 CFR 1.47(a)
For: Synchronous Transmission :
of Data with Network Remote :
Control :
:

This is in response to the petition under 37 CFR 1.47(a), filed April 13, 2001.

The petition is granted.

Petitioner has shown that the non-signing inventor has refused to join in the filing of the above-identified application after having been presented with the application papers.

The above-identified application and papers have been reviewed and found in compliance with 37 CFR 1.47(a). This application is hereby accorded Rule 1.47(a) status.

As provided in Rule 1.47(a), this Office will forward notice of this application's filing to the non-signing inventor at the address given in the petition. Notice of the filing of this application will also be published in the Official Gazette.

The file is being forwarded to the Office of Initial Patent Examination for further processing of the application.

Telephone inquiries regarding this decision should be directed to Petitions Attorney Christina T. Tartera at (703) 306-5589.

Christina T. Tartera

Christina T. Tartera
Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

Beverly M. Flanagan
Beverly M. Flanagan
Supervisory Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

EXTERED
E 062801



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

JOCELYN CLOUTIER
770 18TH AVENUE
MENLO PARK, CA 94025

In re application of
Cloutier, Milewski and Smith
Application No. 09/736,430
Filed: December 15, 2000
For: Synchronous Transmission
of Data with Network Remote
Control

LETTER

COPY MAILED

JUN 26 2001

OFFICE OF PETITIONS
A/C PATENTS

Dear Mr. Cloutier:

You are named as a joint inventor in the above-identified United States patent application filed under the provisions of 35 U.S.C. 116 (United States Code) and 37 CFR 1.47(a), Rules of Practice in Patent Cases. Should a patent be granted on the application you will be designated therein as a joint inventor.

As a named inventor you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 CFR 1.19) or make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent attorney or agent presenting written authorization from you. If you care to join the application, counsel of record (see below) would presumably assist you. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 CFR 1.63.

Telephone inquiries regarding this communication should be directed to Petitions Attorney Christina T. Tartera at (703) 306-5589. Requests for information regarding your application should be directed to the File Information Unit at (703) 308-2733. Information regarding how to pay for and order a copy of the application, or a specific paper in the application, should be directed to Certification Division at (703) 308-9726 or 1-800-972-6382 (outside the Washington D.C. area).

Christina T. Tartera
Christina T. Tartera
Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

Beverly M. Flanagan
Beverly M. Flanagan
Supervisory Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

KENYON & KENYON
1500 K STREET, N.W., SUITE 700
WASHINGTON, DC 20005